

## REMARKS

1. Claims 1-36 have been retained in the application. Applicant has amended claim 27 in accordance with the suggestion of the Examiner. Applicant has also amended claim 4 in accordance with the suggestion of the Examiner. A number of the claims have been revised to correct informalities noted by applicant's attorney upon a further study of the claims and to make the claims even more definite than the claims as originally filed in the application. Claims 37-41 have been added by this amendment. As now written, all of the claims are believed to be definite.

2. Claims 1, 2, 3, 6 and 8 have been rejected under 35 U.S.C. 102(b) as being anticipated by Ouchi patent 5,978,836. As now written, claims 1, 2, 3, 6 and 8 are allowable over Ouchi for certain important reasons.

Claim 1 recites the step of receiving the message at the server from the sender and receiving an indication at the server from the sender that the sender wishes to send the message in a manner special to the sender and not normally provided by the server. There is also a recitation in claim 1 of the step of transmitting from the server to an agent of the recipient the message in the special manner, in accordance with the indication from the server, an identification and address of the server and the identity of the sender.

As now written, claim 1 is allowable over Ouchi for certain important reasons. For example, Ouchi does not disclose the step of receiving the message at the server from the sender and receiving an indication at the server from the sender that the

sender wishes to send the message in a manner special to the sender and not normally provided by the server. This may be seen from the statement by Ouchi in column 12, lines 10-14. This sentence reads as follows.

"The present invention addresses this problem by providing a way to dynamically redefine the route based on choices made by the users on the route to better harness the ever-changing knowledge of the organization. This ability to redefine the route at the user level is of great value." (Underlining supplied.)

Because of this, Ouchi does not disclose the step of transmitting from the server to an agent of the recipient the message in the special manner, in accordance with the indication from the sender to the server, an indication and address of the server and the identity of the sender. Ouchi also does not disclose the step of sending to the sender from the server of the message and the information received by the server from the agent.

Ouchi also does not disclose the step recited in claim 1 of receiving at the server from the agent of the recipient the identity of the agent and an indication of the receipt of the message by the agent and the identification and address of the server and the identity of the sender. For example, Ouchi does not disclose, in the portions of his specification cited by the Examiner, that the server receives from the agent the information specified in claim 1. No disclosure is further provided in Ouchi that the specified information is sent from the server to the sender. The return of information from the recipient to the sender as in Ouchi is not the same as the return of information from the agent of the recipient to the server and then from the server to the sender.

Applicant's system would not be operative if the information were returned from the agent of the recipient directly to the sender.

As will be seen from the above discussion, the sender in applicant's system provides an indication to the server that the server is to process the message on a special basis such as by having the message travel in a different path to the recipient from the path which the message would normally travel to the recipient. This is not how Ouchi's system operates. Furthermore, each of the stations intermediate the server and the recipient in Ouchi's system can subsequently change the path between the intermediate station and the recipient. There are accordingly distinct and patentable differences between applicant's system and Ouchi's system.

Claims 2, 3, 6 and 8 are dependent from claim 1 and are accordingly allowable over Ouchi for the same reasons as claim 1. Claims 2, 3 6 and 8 are also allowable over Ouchi for the following additional reasons:

Claim 2:

Ouchi does not disclose a transmission of information from the server to the agent of the recipient in first and second paths in accordance with an indication, or lack of an indication, provided by the sender to the server.

Claim 3:

Claim 3 is also allowable over Ouchi because Ouchi does not transfer any information from the agent of the recipient to the server.

Claim 6:

Claim 6 is also allowable over Ouchi because Ouchi does not provide an additional indication from the sender to the server that a high priority should be provided by the server to the sending of the message by the server to the agent of the recipient.

Claim 8:

Claim 8 is also allowable over Ouchi because Ouchi does not disclose that an additional indication is provided from the sender to the server with the message that the sending of the message by the server to the agent of the recipient should be recorded by the server.

3. Claims 4, 5, 7, 9-11, 13, 15, 20, 21, 23, 24, 25 and 27-36 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Ouchi in view of Barkan. As now written, all of these claims are allowable for certain important reasons over the combination of Ouchi and Barkan.

Applicant does not consider Barkan to be a proper reference. Barkan discloses methods using encrypted messages to provide communications between users. In view of this, Barkan has to provide a distribution center (e.g., center 63) to provide user 1 with user 2's encryption key so that user 1 can encrypt a message to user 2 with user 2's encryption key and so that user 2 can decrypt the encryption and recover the message. In contrast, applicant provides an unencrypted message. This allows applicant's server to communicate directly with a sender and a recipient.

Barkan also does not disclose a system in which the sender provides an indicator to the server to have the server process a message on a special basis such as by

having the message travel to the recipient in a path different from the path that the message would ordinarily follow.

Furthermore, Barkan does not disclose a digital signature (an encrypted hash) on page 46.

Claims 4, 5, 7, 9-11, 13, 15, 20, 21, 23, 24, 25 and 27-36 are allowable over the combination of Ouchi and Barkan for the following reasons:

Claim 4:

Dependent from allowable claim 3

Neither Ouchi nor Barkan discloses that an encrypted hash of the message is provided by the server to the sender and is sent by the server to the sender with the message after the indication is received by the server from the agent of the recipient. They accordingly cannot be combined to reject the claim.

Claim 5:

Claim 5 is dependent from allowable claim 3.

Neither Ouchi nor Barkan discloses the two (2) method steps recited in the claim. They accordingly cannot be combined to reject the claim.

Claim 7:

Dependent from allowable claim 5

Neither Ouchi nor Barkan discloses the two (2) steps recited in claim 7. They accordingly cannot be combined to reject the claim.

Claim 9:

Dependent from allowable claim 5

Neither Ouchi nor Barkan discloses either one of the two (2) steps recited in claim 9. They accordingly cannot be combined to reject the claim.

Claim 10:

Neither Ouchi nor Barkan discloses the step of receiving at the server with the message from the sender, an indication that the message is to be transmitted in a special manner different from the manner normally provided by the server in transmitting messages. There is also no disclosure in either Ouchi or Barkan of the step of transmitting from the server to an agent of the recipient, in the special manner indicated by the sender to the server, the message and an identification and address of the server and an indication representing the identity of the sender. No disclosure is further provided in either Ouchi or Barkan of the step of transmitting from the server to the sender an encrypted hash of the message and the handshaking and delivery history of the message received by the server from the agent of the recipient.

Claim 11:

Dependent from allowable claim 10

Neither Ouchi nor Barkan discloses either of the steps recited in the last two (2) paragraphs of claim 11. This prevents Ouchi and Barkan from being combined to reject the claim.

Claim 13:

Dependent from allowable claim 11

Neither Ouchi nor Barkan discloses either of the two (2) steps recited in the claim. This prevents Ouchi and Barkan from being combined to reject the claim.

Furthermore, the citation by the Examiner of Ouchi at column 12, lines 40-44 is so general and ambiguous that the cited portion of Ouchi has no meaning.

Claim 15:

Dependent from allowable claim 11

Neither Ouchi nor Barkan discloses either of the two (2) steps recited in claim 15. This prevents Ouchi and Barkan from being combined to reject claim 15.

Claim 20:

Dependent from allowable claim 10

Neither Ouchi nor Barkan discloses that the server requests a delivery status notification from the agent of the recipient relating to the message when it transmits the message to the agent. No disclosure is further provided by Ouchi or Barkan that the server receives the delivery status notification from the agent of the recipient when it receives the message from the agent. Since neither Ouchi nor Barkan provides these disclosures, they cannot be combined to reject claim 20.

Claim 21:

Neither Ouchi nor Barkan discloses the step of receiving at the server from the sender an indication, with the message from the sender at the server, that the message is to be handled by the server in a particular manner different from the normal handling of the message at the server. No disclosure is further provided in either Ouchi or Barkan that the server handles the message at the server in the particular manner, in accordance with the indication from the sender at the server, in transmitting the message to the recipient.

Claim 22:

Dependent from allowable claim 21

Neither Ouchi nor Barkan discloses that the message is handled by the server in the normal manner when the indication is not provided by the sender to the server with the message and that the message is handled by the server in the particular manner when the indication is provided by the sender to the server with the message. This prevents Ouchi and Barkan from being combined to reject claim 22.

Claim 23:

Dependent from allowable claim 22

Neither Ouchi nor Barkan discloses either one of the two (2) steps recited in claim 23. This prevents Ouchi and Barkan from being combined to reject claim 23.

Claim 24:

Dependent from allowable claim 23

Each of the two (2) steps recited in claim 24 is not disclosed in either of Ouchi or Barkan. This prevents claim 24 from being rejected by a combination of Ouchi and Barkan.

Claim 25:

Dependent from allowable claim 21

Neither Ouchi nor Barkan discloses either of the two (2) steps recited in claim 25. This prevents the references from being combined to reject the claim.



Claim 27:

Claim 27 recites the step of normally transmitting from the server to the agent of the recipient in a first route the message and the identity of the sender and the identity and address of the server. Claim 27 also recites the step of providing an indication at the server from the sender that the message from the sender should be transmitted by the server to the agent of the recipient through a second route different from the first route. A recitation is also made in claim 27 of the step of transmitting the message from the server to the agent of the recipient through the second route in accordance with the indication provided to the server from the sender. Neither Ouchi nor Barkan discloses any of these steps. Claim 27 is accordingly allowable over the combination of Ouchi and Barkan for the reasons specified above.

Claim 28:

Dependent from allowable claim 27

Claim 28 is allowable over each of Ouchi and Barkan because each of these references fails to disclose that the message and the encrypted hash of the message and the identity of the sender and the identity and address of the server and the identity and address of the agent of the recipient and the status at the agent of the reception of the message by the agent are transmitted by the server to the sender.

Claim 29:

Dependent from allowable claim 27

Neither Ouchi nor Barkan discloses either one of the two (2) steps recited in claim 29.

Claim 30:

Dependent from allowable claim 29

There is no disclosure in Ouchi or Barkan of either one of the two (2) steps recited in claim 30.

Claim 31:

Dependent from allowable claim 28

No disclosure is provided in either Ouchi or Barkan of any one of the three (3) steps recited in claim 31. Specifically, the references do not disclose that the sender provides at the server for an indication of an additional function to be performed at the server. Neither of the references further specifies that the additional function provides for the message to be specially handled in the transmission of the message from the server through the second route to the agent of the recipient.

Claim 32:

Neither Ouchi nor Barkan discloses any one of the steps recited in claim 32. This prevents Ouchi and Barkan from being combined to reject claim 32.

Claim 33:

Dependent from allowable claim 32

There is no disclosure in either Ouchi or Barkan that the server destroys the message and the encrypted hash of the message after the server transmits the message and the encrypted hash of the message to the sender. There is also no disclosure in either Ouchi or Barkan that the server produces hashes from the message and the encrypted

hash and that the server authenticates the message by comparing the hashes to determine if they are identical.

Claim 34:

Dependent from allowable claim 32

No disclosure is provided in either Ouchi or Barkan of either one of the two (2) steps recited in claim 34. This prevents Ouchi and Barkan from being combined to reject claim 34.

Claim 35:

Dependent from allowable claim 34

Ouchi and Barkan do not disclose either one of the two (2) steps recited in claim 35. This prevents Ouchi and Barkan from being combined to reject claim 35.

Claim 36:

Dependent from allowable claim 35

Claim 36 is allowable over the combination of Ouchi and Barkan for the reasons set forth in claims 34 and 35.

4. Claims 12, 14, 18 and 29 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Barkan in view of Ouchi and further in view of Merriam patent 6,609,138. Claims 12, 14, 18 and 19 are allowable over the combination of Barkan, Ouchi and Merriam because they are dependent from allowable claims which have been discussed above. Claims 12, 14, 18 and 19 are also allowable over the combination of Barkan, Ouchi and Merriam for additional reasons which are discussed below:

Claim 12:

Dependent from allowable claim 11

Contrary to the position of the Examiner, Ouchi does not disclose that the message is sent by the server to the sender after the server receives from the agent of the recipient the handshaking and delivery history of the transmission of the message from the server to the agent of the recipient. Furthermore, contrary to the position of the Examiner, Merriam does not disclose that the server does not retain the message after it sends the message to the sender.

Claim 14:

Dependent from allowable claim 11

Claim 14 is allowable over the combination of Ouchi, Barkan and Merriam because none of the references discloses that the additional indication from the sender to the server provides for an archiving of the message and that the message is archived in accordance with the additional indication from the sender to the server.

Claim 18:

Dependent from allowable claim 11

Claim 18 is also allowable over the combination of Ouchi, Barkan and Merriam for substantially the same reasons as claim 12.

Claim 19:

Dependent from allowable claim 10

Furthermore, none of Ouchi, Barkan and Merriam discloses any of the steps recited in claim 19. This prevents Ouchi, Barkan and Merriam from being combined to reject claim 19.

5. Claims 22 and 26 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Barkan in view of Ouchi and in view of Olkin patent 6,584,564. Claim 22 is dependent from allowable claim 21 and is accordingly allowable over the combination of Ouchi and Barkan for the same reasons as claim 21. Furthermore, contrary to the position of the Examiner, Olkin does not disclose that a server generates for any attachment to the message, an encrypted hash of the attachment and transmits at the server the attachment and the encrypted hash of the attachment to the sender at the same time, and in the same manner, that the message and the encrypted hash of the message are transmitted at the server to the sender. Barkan and Ouchi also do not disclose these steps. Because of this, Ouchi, Barkan and Olkin cannot be combined to reject claim 22.

Claim 26:

Since claim 26 is dependent from claim 22, it is allowable over the combination of Barkan, Ouchi, and Olkin for the same reasons as claim 22. Claim 26 is also allowable over the combination of Barkan, Ouchi and Olkin because none of the references discloses the steps recited in claim 26.

6. Claims 37-41 have been added by this amendment. Claims 37-41 are dependent from allowable claims originally filed in the application and are accordingly allowable over the references because of these dependencies. Claims 37-41 are also

allowable over the references because the references do not disclose that the server transmits the message and the encrypted hash of the message to the sender and operates upon the message and the encrypted hash from the sender to authenticate the message.

7. In order for different prior art references to be combined to reject a claim, the references have to disclose or suggest the combination recited in the claim. ACS Hospitality Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). As the Federal Circuit indicated in the ACS case at 732 F.2d. 1572, 1577, 221 USPQ 929, 933:

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. Under Section 103, teaching of references can be combined only if there is some suggestion or incentive to do so.”

See also In re Fine, 837 F.2d 1071, 5 USPQ 2d. 1596, (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ 2d. 1941 (Fed. Cir. 1992) in support of the holding in the ACS case.

None of the references cited by the Examiner to reject the claims in this application discloses or suggests certain of the features recited in the claims. These features are specified above for each of the claims in the application. This has been discussed above in some detail. The references cannot accordingly be combined to reject the claims.

8. Reconsideration and allowance of the application are respectfully requested.

9. Please charge any costs or credit any fees in connection with this application to Account No. 06-2425.

Respectfully submitted,

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